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PATENT
Customer No. 22,852
Attorney Docket No. 02481.1773

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

PEYMAN et al.

Serial No.: 10/004,422

Filed: December 6, 2001

For: NEW GUANIDINE AND AMIDINE
DERIVATIVES AS FACTOR Xa
INHIBITORS

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) Group Art Unit: 1627

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) Examiner: C. Chang
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Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated February 3, 2003, the Office required restriction under 35 U.S.C. § 121 to one of the following:

Group I: Claims 4-6, drawn to compounds where D is a carbon compound, classified in various classes and subclasses (depending on which species is elected). Generic claims 1-3 and 7-13 will be examined with this group to the extent that they read on the elected compounds.

Group II: Claims 2-3, drawn to compounds where D is nitrogen, classified in class 546 and various subclasses (depending on which species is elected). Generic claims 1 and 7-13 will be examined with this group to the extent that they read on the elected compounds.

Group III: Claim 1, drawn to compounds where D is oxygen, sulfur, or any other substituent not encompassed by groups I or II, classified in various classes and subclasses (depending on which species is elected). Generic claims 7-13 will be examined with this group to the extent that they read on the elected compounds.

In response, Applicants elect to prosecute Group I, claims 1-6 and 7-13, drawn to compounds where D is a carbon compound, with traverse.

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The Office also requires Applicants to elect a species from whichever group is elected for prosecution. Applicants elect, with traverse, the species provided on page 34, Example 2: 4-bromo-N-(1-carbamimidoyl-piperidin-4-ylmethyl)-3-[2-(2,4-dichlorophenyl)-ethoxy]-5-hydroxy-benzamide. Claims 1-6 and 7-13 all read on the elected species.

In traversing the restriction requirement, Applicants draw the Office's attention to M.P.E.P. § 803, which sets forth the criteria that the Office must satisfy to make a restriction requirement. In particular, restriction of Applicants' invention is not proper unless examination of the claims results in a serious burden on the Examiner.

In the present case, the Office has not shown that there would be a serious burden to examine Groups I-III together. The compounds share a common core structure that may be readily searched given the automated resources available for doing so. Very little additional time is required to change the D substituent in the claimed structure from O to S to N, *etc.* as the search progresses. Thus, a search encompassing the subject matter recited in Groups I-III would not be burdensome, as the information relevant to a determination of patentability may be located without much additional effort. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

For similar reasons, the Office should withdraw the election of species requirement. As noted above, the compounds of formula I are represented by a common core structure that does not impose a serious burden to search. Thus, the full scope of species embraced by the claims should be included in the search. Applicants also remind the Office that if the elected species is found allowable, pursuant to

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M.P.E.P. § 803.02, the search must be expanded to encompass the additional species in the claim.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: March 3, 2003

By: 

M. Todd Rands
Reg. No. 46,249

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